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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,113	09/26/2000	William Y. Conwell	60299	4862

23735 7590 07/15/2004

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 250  
TUALATIN, OR 97062

EXAMINER

PATEL, SHEFALI D

ART UNIT	PAPER NUMBER
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2621

10

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/670,113

Applicant(s)

CONWELL, WILLIAM Y.

Examiner

Shefali D Patel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-18 is/are allowed.
- 6) ☒ Claim(s) 3,5,8 and 9 is/are rejected.
- 7) ☒ Claim(s) 19,20 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment was received on May 21, 2004.
2. Claims 3, 5, and 8-9 were allowed (in an Quayle Action) but they are now amended to broaden their scope.
3. Claims 6-7 were considered directed to an invention that is independent or distinct from the invention originally claimed. Applicant withdraws the claims 6-7; these claims need to be cancelled in case of an allowance of the application.

### ***Response to Arguments***

1. Applicant's arguments filed on May 18, 2004 have been fully considered but they are not persuasive. Applicant does not argue regarding a prior art since there was no prior art rejection made in the Quayle Action. However, applicant argues in reference to the restriction requirement concerning claims 6-7 made in the Quayle Action. The restriction requirement still stands and claims 6-7 should be cancelled instead of withdrawn.

### ***Claim Objections***

2. Claim 21 is objected to because of the following informalities: Claim 21 depends on claim 6 which should be a cancelled claim. This is an improper dependent claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhoads (USPN 5,841,886).

With regard to **claim 3** Rhoads discloses a method comprising: receiving data corresponding to an image, the image including a depiction of text (See column 6 lines 58-63, here the document 1000 includes the image at 1010 and text at 1012, as also seen in Figure 6); recognizing at least some of said depicted text (text recognized by extracting identification code from the photo, See col. 7 lines 37-38); and encoding a watermark (i.e., embedded code signal in a digital image at col. 7 line 36) in said image, said watermark serving to associate said image with said recognized text (i.e., embedded code signal in a digital image at col. 7 line 36, 41-46).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US 5,841,886) in view of Shim et al. ("Automatic text Extraction from Video for Content-Based Annotation and Retrieval," IEEE, 1998) (hereinafter, "Shim").

With regard to **claim 5** Rhoads discloses a method of claim 3 as disclosed above. Rhoads does not expressly disclose recognizing the depicted text by an automated OCR process. Shim discloses this on page 2 column 2 section 2.1.3. and under section 2.1.4. lines 9-14. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine

the teaching of Shim with Rhoads. The motivation for doing so is to produce ASCII text from an image as suggested by Shim. Therefore, it would have been obvious to combine Shim with Rhoads to obtain the invention as specified in claim 5.

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US 5,841,886) in view of Alves (US 6,747,687).

With regard to **claim 8** Rhoads discloses analyzing an image with depicted text, digitally watermarking the image where the watermark is associated with the text information as disclosed in claim 3 above and is incorporated herein. Rhoads does not expressly disclose having a security monitoring camera capturing a frame of image data. Alves discloses this at col. 5 lines 57-65. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Alves with Rhoads. The motivation for doing so is that it is obvious to use a camera to capture an image in real-time than a computer 942 in Rhoads since it serves the same purpose. Therefore, it would have been obvious to combine Alves with Rhoads to obtain the invention as specified in claim 8.

With regard to **claim 9** Alves discloses the frame of image data including a depiction of a vehicle license plate at col. 5 lines 1-4 and line 65 to col. 6 lines 1-2.

***Allowable Subject Matter***

8. Claims 19-20 and 22 are objected to (for the same reasons as stated in the Quayle action) as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 10-18 are allowed.

The instant invention defines a method of watermarking. The claimed invention distinguishes over the prior art by the manner in which the document for text information is being analyzed using an OCR process. The claimed combination allows for improving a method of receiving an electronic document, the document comprising a graphical representation of text, but not including ASCII data corresponding thereto; analyzing said document for text information using an OCR process; and digitally watermarking said electronic document; wherein said digital watermark associates the electronic document with the text information as disclosed in claim 10. An apparatus comprising a scanner for producing scan data corresponding to an original document; an OCR engine for recognizing text from said scan data; and a watermarker that alters an output from said apparatus to encode a watermark therein, the watermark serving to associate said output with said stored text as disclosed in claim 16.

Watermarking is conventional. However, the prior art of record fails to teach the method and an apparatus as claims in independent claims 10 and 16. These elements in combination with all of the other elements of the claims are not taught or fairly suggested in the prior art of record. The dependent claims 11-15 and 17-18 are allowed for the same reasons.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D Patel whose telephone number is 703-306-4182. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**DANIEL MARIAM**  
**PRIMARY EXAMINER**

July 9, 2004

Shefali D Patel  
Examiner  
Art Unit 2621